Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte EDWARD L. INGRAM and MARY E. SCOTT

Appeal No. 2003-0443
Application No. 09/465,653

ON BRIEF

Before WINTERS, ADAMS and GREEN, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-7, which are all the claims pending in the application.

Claim 3 is illustrative of the subject matter on appeal and is reproduced below:

> 3. A composition which consists essentially of a combination of:
>
> c. Alchohol [sic];
> d. Turpentine; and
> e. Eucalyptus Oil;
>
> and wherein said combination comprises an amount of alcohol from about 25 percent to 40 percent by volume.[1]

[1] It is unclear on this record why the lettered bullets in this claim start at letter "c" and not - - a - -. For the purposes of this appeal we assume that a typographical error was made and the bullets should be lettered - - a–c - - and not "c-e". We encourage the examiner to clarify this issue prior to any further action on the merits.

The references relied upon by the examiner are:

Deckner et al. (Deckner)	4,919,934	Apr. 24, 1990
Arora	5,223,257	Jun. 29, 1993

International Application:

Went et al. (Went)	WO 90/07331	Jul. 12, 1990

GROUND OF REJECTION

Claims 1-7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Arora in combination with Deckner and Went.

We reverse.

DISCUSSION

According to the examiner (Answer, page 3), Arora discloses a composition comprising eucalyptus oil, alcohol in the amount of about 25 to about 40 parts by volume per 100 parts by volume and an analgesic agent that may be methyl salicylate. See Arora, column 1, lines 45-65. The examiner recognizes, however, that Arora does not teach turpentine. To make up for this deficiency the examiner relies on Deckner and Went. The examiner finds (Answer, page 3) that Deckner discloses a cosmetic stick comprising a cosmetically or therapeutically active agent, which include, inter alia, methyl salicylate, turpentine oil and eucalyptus oil. The examiner also finds (Answer, page 4) that Went teaches:

> Using turpentine, methyl salicylate esters, and/or eucalyptus oil, either alone or in combination, to enhance the penetration of a topical anti-inflammatory and pain reducing agent. See p.[ ]2, line 2 – p. 7, line 21; p.[ ]17, line 20-13[sic]. The reference notes the synergism effect of turpentine, methyl salicylate esters, and/or eucalyptus oil on the primary anti-inflammatory agent, which again suggests that these components have equivalent functions.

Based on this evidence, the examiner concludes (id.),

> [i]t would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the composition in Arora by replacing methyl salicylate with turpentine oil, as suggested by Deckner et al. and Went et al., because of the expectation of successfully producing a similar analgesic composition with equivalent effectiveness and skin penetration without adverse effects.

As we understand the examiner's rejection, since Deckner and Went disclose the equivalent function of turpentine, eucalyptus oil and methyl salicylate[2], it would have been prima facie obvious to substitute turpentine for methyl salicylate in the composition disclosed by Arora. Notwithstanding the examiner's arguments, the evidence relied upon by the examiner also leads a person of ordinary skill in the art to a composition comprising methyl salicylate, turpentine and alcohol, which is not the claimed invention. While the examiner suggests that turpentine, eucalyptus oil and methyl salicylate are equivalent in function, the examiner failed to provide any evidence as to why a person of ordinary skill in the art would have modified the Arora composition by substituting turpentine for methyl salicylate, and not for eucalyptus oil.

Prima facie obviousness based on a combination of references requires that the prior art provide "a reason, suggestion, or motivation to lead an inventor to combine those references." Pro-Mold and Tool Co. v. Great Lakes Plastics Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996).

> [E]vidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. . . . The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular.

[2] Methyl salicylate is also known as wintergreen oil. See Arora, column 1, line 48.

In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (citations omitted). The suggestion to combine prior art references must come from the cited references, not from the application's disclosure. See In re Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

On this record, the examiner has selectively chosen parts of the prior art that support her position, while excluding other parts which lead to an equally viable, yet distinct composition than that claimed. In this regard, we remind the examiner "it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art." In re Wesslau, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965); see also In re Mercer, 515 F.2d 1161, 1165-66, 185 USPQ 774, 778 (CCPA 1975).

For the foregoing reasons, we reverse the rejection of claims 1-7 under 35 U.S.C. § 103 as being unpatentable over Arora in combination with Deckner and Went.

REVERSED

Sherman D. Winters Administrative Patent Judge	)
Donald E. Adams Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
Lora M. Green Administrative Patent Judge	)

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